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Nils-Erik Engstrom

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EXAMINER

SPAHN, GAY

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,191	Applicant(s) ENGSTROM, NILS-ERIK	
	Examiner Gay Ann Spahn	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/16/09, 4/16/09, 7/31/09, and 10/9/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/22/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment to the specification filed on 09 October 2009 does not comply with the requirements of 37 CFR 1.121(b) because:

(1) the amended Abstract has not been amended properly with respect to the immediate prior version of the Abstract filed with the Preliminary Amendment on 23 May 2006 in which the reference numerals were already taken out. In addition, the examiner notes that on line 2 and line 3 of the amended Abstract filed 09 October 2009, the word "includes" should be underlined and the word "comprises" should be stricken-through either before or after the underlined word "includes" if Applicant is attempting to change the word "comprises" to –includes—. Further, on line 5 of the amended Abstract, the word "allow" has not been amended correctly from the original word "allowing" (i.e., it should either be ~~allowing~~ or allow[[ing]]).

Amendments to the specification filed on or after July 30, 2003 must comply with 37 CFR 1.121(b) which states:

(b) Specification . Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) Amendment to delete, replace, or add a paragraph . Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

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(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) Amendment by replacement section . If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification. The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and

(c).

(4) Reinstatement of previously deleted paragraph or section . A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document . Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

However, in order to advance prosecution, the examiner is simply not entering the specification amendments filed in the amendment document on 09 October 2009 and is repeating her specification objections below.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 22 January 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

However, the second of the three references in the "Foreign Patent Documents" has been lined through as not being considered be as failing to comply with 37 C.F.R. 1.98(a)(2)(i) because no copy of Japanese Patent Application Publication No. JP 8086078 has been received (i.e., the Patent Abstracts of Japan corresponding to this Japanese Patent Application Publications should be listed in the "Other Documents" section if only the abstract is to be considered).

Drawings

The drawings were received on 16 January 2009. These drawings are NOT acceptable to the examiner for the reasons as set forth below.

The drawings are objected to because:

(1) Fig. 1a, the lead lines leading from reference numerals "21" and "23" should not cross in accordance with the fourth sentence of 37 CFR 1.84(q); and

(2) Fig. 3a, the lead line leading from reference numeral "14" should not cross the line showing the distance P in accordance with the fourth sentence of 37 CFR 1.84(q).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract

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on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure (filed with the Preliminary Amendment on 23 May 2006) is objected to because:

(1) second to last line, the words "so as to allowing it to be located" after the words "section, the joining profile being so configured" is grammatically incorrect.

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

(1) page 7, lines 13-14, each of Fig. 1a, Fig. 1b, and Fig. 1c must be described separately;

(4) page 7, line 15, the word "third" should be changed to --second--;

(5) page 7, lines 17-18, there is no Fig. 3, only Fig. 3a, Fig. 3b, and Fig. 3c, and each of these figures must be described separately;

(6) page 8, line 1, the word "wile" should be changed to --while--; and

(7) page 11, line 7, the sentence cannot end in "the." (i.e., there appears to be a word or words missing).

Appropriate correction is required.

Claim Objections

Claims 1-7 and 10-13 are objected to because of the following informalities:

(1) **claims 1-7 and 10-13**, according to the Manual of Patent Examining Procedure (MPEP), § 608.01, entitled “Form of Claims”, “[w]hile there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with ‘I (or we) claim,’ ‘The invention claimed is’ (or the equivalent)” and therefore, the centered “CLAIMS” at the top of page 13 should be changed to “I claim:” or “The invention claimed is:” or similar;

(2) **claim 3**, line 3, there is no period punctuation mark at the end of the line 3 even though amended claim 3 in the Preliminary Amendment of 23 May 2006 has a period punctuation mark at the end thereof;

(3) **claim 6**, line 2, the word –a-- should be inserted between the words “in” and “horizontal” for proper grammar; and

(4) **claim 11**, lines 1-2, the words “wherein a portion arranged between the upper side groove and is respective distal edge portion” is grammatically incorrect and it is believed that the word “is” should be changed to –its-- for proper grammar.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 1, the recitation of “A joint for a panel” is vague, indefinite, and confusing as not being clear. Dictionary.com defines the word “joint” is defined as:

1. The place at which two things, or separate parts of one thing, are joined or united, either rigidly or in such a way as to permit motion; juncture.
2. a connection between pieces of wood, metal, or the like, often reinforced with nails, screws, or glue.

How can a single panel have a joint? Therefore, the examiner suggests amending to --A joint for two panels--.

Claim 1, line 5, the pronoun “it” is vague, indefinite, and confusing as lacking antecedent basis. What does “it” refer back to?

Claim 1, line 6, the recitation of “the joint between two, joined, adjacent panels” is vague, indefinite, and confusing as lacking antecedent basis? Is this referring back to “A joint for a panel” introduced in line 1 or is Applicant reciting a second joint?

Claim 1, line 6, the recitation of “two, joined, adjacent panels” is vague, indefinite, and confusing. Is one of the two, joined, adjacent panels the same panel as mentioned in line 1 (i.e., for a panel)?

Claim 2, lines 4-5, the recitation of “the joining profile is further provided with a first and second snapping tongue” is vague, indefinite, and confusing.

First, is “a first and second snapping tongue” singular or should it be changed to --[[a]] first and second snapping tongues--? What is “a first and second snapping

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tongue” (i.e., what structure is represented by “a first and second snapping tongue”)?

What structure makes the tongue a “snapping” tongue?

Second, does the joining profile have a tongue (claim 1, line 4) AND “a first and second snapping tongue” (claim 2, line 5) or is “a first and second snapping tongue” referring back to the tongue recited in claim 1, line 4? How many tongues are being recited? One (i.e., the tongue in claim 2 is singular and the same tongue as in claim 1)? Two (i.e., the tongue in claim 2 is singular and is the same tongue as in claim 1 OR the tongue in claim 2 is plural, but one of the plural tongues is the same tongue as in claim 1)? Three (i.e., the tongue in claim 2 is plural and is not the same tongue in claim 1)?

Claim 2, lines 6-7, the recitation of “the joining profile being so configured so as to allow the first and second snapping tongue to be fitted in upper side grooves of two, joined, adjacent panels” is vague, indefinite, and confusing.

First, how can a singular first and second snapping tongue be fitted into plural upper side grooves of plural panels?

Second, “upper side grooves” lacks antecedent basis because it is not clear if this is referring back to the already introduced upper side groove of the first edge (claim 2, lines 3-4) and the already introduced upper side groove of the second edge (claim 1, line 3). OR are “upper side grooves of two, joined, adjacent panels” different structure from the upper side grooves of the first and second edges of the joint?

Third, the recitation of “two, joined, adjacent panels” lacks antecedent basis. Is one of the two, joined, adjacent panels the same panel as mentioned in line 1 of claim 1

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(i.e., for a panel)? Are the two, joined, adjacent panels the same panels as mentioned in line 6 of claim 1?

Claim 3, lines 1-2, the recitation of “the joint further comprises the mating surfaces” is vague, indefinite, and confusing.

First, the recitation of “the mating surfaces” lacks antecedent basis as no mating surfaces have been previously introduced.

Second, how can the joint further comprise “the mating surfaces” (i.e, how can the joint comprise something that has already been introduced as denoted by the article “the”)?

Third, what is the difference between “the mating surfaces” and the first and second edges? Applicant appears to be referring to the same structure by differing terminology which is not allowed in patent claims.

Claim 3, lines 2-3, the recitation of “wherein the joining profile and the upper side grooves are so configured that a play is created in the joint between the mating surfaces” is vague, indefinite, and confusing as not being clear.

First, the recitation of “the upper side grooves” is vague, indefinite, and confusing. Is this referring back to the upper side grooves in the first and second edges (claim 1, line 3 and claim 2, lines 3-4) or upper side grooves of two, joined, adjacent panels (claim 2, line 7).

Second, the recitation of “the mating surfaces” is vague, indefinite, and confusing. What is the difference between “the mating surfaces” and the first and

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second edges? Applicant appears to be referring to the same structure by differing terminology which is not allowed in patent claims.

Third, it is not clear what is meant by “a play is created in the joint between the mating surfaces”? Since it is not clear what constitutes “the mating surfaces”, it is not clear how or where the play is created.

Claim 4, lines 1-2, the recitation of “wherein the play is in the range of 0.05 – 1 mm” is vague, indefinite, and confusing as not being clear. How is the play measured? Since it is not clear what structure constitutes “the mating surfaces”, it is not clear where the 0.5 - 1 mm is being measured.

Claim 5, line 1, the recitation of “the tongue” is vague, indefinite, and confusing as lacking antecedent basis. Is this referring to the tongue of the second edge (claim 1, line 3) or the tongue of the joining profile (claim 1, line 4)?

Claim 5, line 2, the recitation of “the groove” is vague, indefinite, and confusing as lacking antecedent basis. Is this referring to the groove of the first edge (claim 1, line 2) or the upper side groove of the second edge (claim 1, line 3)?

Claim 5, lines 2-3, the recitation of “two adjacent panels” is vague, indefinite, and confusing. Is this referring to the panel in claim 1, line 1 or the two, joined, adjacent panels in claim 1, line 6?

Claim 6, line 3, the recitation of “two adjacent panels” is vague, indefinite, and confusing. Is this referring to the panel in claim 1, line 1 or the two, joined, adjacent panels in claim 1, line 6 or the two, joined, adjacent panels in claim 2, line 7?

Claim 7, lines 1-3, the recitation of “wherein a portion arranged between the upper side groove and its respective distal edge portion comprises a recess” is vague, indefinite, and confusing as not being clear.

First, the recitation of “a portion arranged between the upper side groove and its respective distal edge portion” is vague, indefinite, and confusing. A portion of what? What is “its respective distal edge portion” referring back to (i.e., the upper side groove or the portion)? What is the pronoun “its” referring back to? What does “respective distal edge portion” mean (i.e., what structure represents the “distal edge portion” and what does “respective” mean)?

Second, the recitation of “the upper side groove” is vague, indefinite, and confusing as lacking antecedent basis. Is this referring to the upper side groove in the second edge (claim 1, line 3) or the upper side groove in the first edge (claim 2, lines 3-4)?

Third, it is not clear what structure constitutes the recess?

Claim 10, lines 1-2, the recitation of “wherein the first groove edge surface will create a pressure on an outer edge of the joining profile when two adjacent panels are forced together, the pressure causing the intermediate section to be urged downwards” is vague, indefinite, and confusing as not being clear.

First, the recitation of “the first groove edge surface” lacks antecedent basis since no first groove edge surface has been previously recited. What structure is this referring to?

Second, the recitation of “two adjacent panels” also lacks antecedent basis. Is this referring to the panel in claim 1, line 1 or the two, joined, adjacent panels in claim 1, line 6 or the two, joined, adjacent panels in claim 2, line 7?

Third, how does the first groove edge surface create a pressure on the outer edge of the joining profile when two adjacent panels are forced together and how does that pressure cause the intermediate section to be urged downwards?

Claim 10, lines 2-3, the recitation of “two adjacent panels” is vague, indefinite, and confusing. Is this referring to the panel in claim 1, line 1 or the two, joined, adjacent panels in claim 1, line 6 or the two, joined, adjacent panels in claim 2, line 7?

Claim 11, line 2, the recitation of “wherein a portion arranged between the upper side groove and is respective distal edge portion comprise a recess, the recess being adapted to receive the lower portion of the intermediate section when being urged downwards” is vague, indefinite, and confusing as not being clear.

First, the recitation of “a portion arranged between the upper side groove and is respective distal edge portion” is vague, indefinite, and confusing. A portion of what? What is “is respective distal edge portion” referring back to (i.e., the upper side groove or the portion)? Should “is” be “its” and if so, what is the pronoun “its” referring back to? What does “respective distal edge portion” mean (i.e., what structure represents the “distal edge portion” and what does “respective” mean)?

Second, the recitation of “the upper side groove” is vague, indefinite, and confusing as lacking antecedent basis. Is this referring to the upper side groove in the

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second edge (claim 1, line 3) or the upper side groove in the first edge (claim 2, lines 3-4)?

Third, it is not clear what structure constitutes the recess?

Fourth, the recitation of “the lower portion” is vague, indefinite, and confusing as lacking antecedent basis.

Claim 12, lines 1-2, the recitation of “the upper side groove” is vague, indefinite, and confusing as lacking antecedent basis. Is this referring to the upper side groove in the second edge (claim 1, line 3) or the upper side groove in the first edge (claim 2, lines 3-4)?

Claim 12, lines 1-2, the recitation of “the distance being so configured that the snapping tongue may be pressed in between the first and second groove edge surfaces” is vague, indefinite, and confusing as not being clear. How can a distance be “configured”?

Claim 13, lines 1-2, the recitation of “the first and second groove edge surfaces are arranged so that an undercut is present” is vague, indefinite, and confusing as not being clear. Since no undercut is labeled in the drawings, the examiner does not understand what structure represents the undercut.

Claim 13, lines 2-4, the recitation of “that the snapping tongue of the joining profile is configured with respect to the undercut so that a snap action locking effect is achieved” is vague, indefinite, and confusing as not being clear. How is the snapping tongue of the joining profile configured with respect to the undercut? How is a snap action locking effect achieved (i.e., what structure allows for this)?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by BYERS (U.S. Patent No. 2,282,559 cited on IDS filed 6/12/2008).

As to claim 1 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses a joint for a panel, the joint comprising

a first edge (left edge of tile 10 in Fig. 2) and

a second edge (right edge of tile 10 in Fig. 2)

whereby the first edge comprises a groove (12) and the second edge is provided with a tongue (11)

wherein the second edge further comprises an upper side groove (14/15), and

a joining profile (13) is provided with a tongue (either 13a or 13b) and an intermediate section (middle of 13 between 13a and 13b), the joining profile (13) being so configured so as to allow it to be located in the upper portion (3, 3) of the joint between two, joined, adjacent panels (10, 10).

As to claim 2 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 1 as discussed above, and BYERS also discloses that the first edge further comprises an

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upper side groove (14/15) and the joining profile (13) is further provided with a first and second snapping tongue (other of 13a or 13b), the joining profile (10) being so configured so as to allow the first and second snapping tongue (other of 13a or 13b) to be fitted into upper side grooves (14/15, 14/15) of two, joined, adjacent panels (10, 10).

As to claim 3 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 2 as discussed above, and BYERS also discloses that the joint further comprises mating surfaces (surfaces of first and second edges), wherein the joining profile (13) and the upper side grooves (14/15, 14/15) are so configured that a play is created in the joint between the mating surfaces.

As to claim 5 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 1 as discussed above, and BYERS also discloses that the tongue (11) and the groove (12) are configured to limit the movement in a vertical direction between two adjacent panels (10, 10).

As to claim 6 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 2 as discussed above, and BYERS also discloses that the joining profile (13) and the upper side grooves (14/15, 14/15) are configured to limit the movement in horizontal direction between two adjacent panels (10, 10).

As to claim 7 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 2 as

discussed above, and BYERS also discloses that a portion arranged between the upper side groove (14/15) and its respective distal edge portion comprises a recess (15).

As to claim 10 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 2 as discussed above, and BYERS also discloses that the first groove edge surface (longer edge surface of 14) will create a pressure on an outer edge of the joining profile (13) when two adjacent panels (10, 11) are forced together, the pressure causing the intermediate section (middle of 13) to be urged downwards.

As to claim 11 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 10 as discussed above, and BYERS also discloses that a portion arranged between the upper side groove (14/15) and its respective distal edge portion comprises a recess (15), the recess (15) being adapted to receive the lower portion of the intermediate section (middle of 13) when being urged downwards.

As to claim 12 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 2 as discussed above, and BYERS also discloses that the upper side groove (14/15) is provided with a first groove edge surface (left surface of left 14 or right surface of right 14) and a second groove edge surface (right surface of left 14 or left surface of right 14), and between the first and second groove edge surfaces a predetermined distance is present, the distance being so configured that the snapping tongue (13a or 13b) may be pressed in between the first and second groove edge surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over

BYERS (U.S. Patent No. 2,282,559 cited on IDS filed 6/12/2008).

As to claim 4 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 3 as discussed above.

BYERS fails to explicitly disclose that the play is in the range 0.05 - 1 mm.

It is well settled that changes in size/proportion do not constitute a patentable difference. See *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), wherein the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the joint of BYERS by making the play between the mating surfaces be in the range of 0.005 mm to 1 mm in order to allow adjacent panels to move slightly with respect to each other.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over BYERS (U.S. Patent No. 2,282,559 cited on IDS filed 6/12/2008) in view of CORDES (German Patent Application Publication No. DE 33 04 992 cited on IDS filed 5/23/2006).

As to claim 12 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS discloses the joint of claim 2 as discussed above.

In the alternative, BYERS may fail to explicitly disclose that the upper side groove is provided with a first groove edge surface and a second groove edge surface between the first and second groove edge surfaces a predetermined distance is present, the distance being so configured that the snapping tongue may be pressed in between the first and second groove edge surface.

CORDES (Fig. 5) discloses a joint with upper side grooves (grooves 5c, 5d in left and right side edges of 1, 1) and a joining profile (5), wherein the upper side groove (either 5c or 5d) is provided with a first groove edge surface and a second groove edge surface, and between the first and second groove edge surfaces a predetermined distance is present, the distance being so configured that the snapping tongue (5a or 5b) may be pressed in between the first and second groove edge surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the joint of BYERS by making the upper side groove and the joining profile thereof be configured like the upper side groove and joining profile as taught by CORDES in order to better lock the panels together.

As to claim 13 (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), BYERS in view of CORDES discloses the joint of claim 12 as discussed above, and the resulting joint from the combination of BYERS in view of CORDES also discloses that the first and second groove edge surfaces are arranged so that an undercut is present, that the snapping tongue (either 5a or 5b of CORDES) of the joining profile (5 of CORDES) is configured with respect to the undercut so that a snap action locking effect is achieved.

Response to Arguments

Applicant's arguments with respect to claims 1-7 and 10-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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/Gay Ann Spahn/
Gay Ann Spahn, Patent Examiner
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